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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,982	12/27/2000	Yoriko Azuma	0033-0684P	3639

7590 07/12/2005

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EXAMINER
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DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/747,982

Applicant(s)

AZUMA, YORIKO

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,5 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 8-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1, 4, 5, 8-21 have been examined.

#### *Response to Amendment*

2. The Amendment filed on 5/18/05 is insufficient to overcome the Goldhaber and Reilly reference.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4, 5, 8-10, 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (5,794,210) in view of Reilly (5,740,549).

Claims 1, 4, 5, 8-9, 16: Goldhaber et al teaches an electronic advertisement receiving apparatus comprising electronic advertisement receiving means (col. 5, lines 50-55, col. 9, lines 60-67); presenting means for presenting the advertisement (col. 9, lines 40-50, fig. 11); and presentation informing means for informing the advertiser of presentation information (col. 7, lines 55-67, col. 17, lines 30-40). Goldhaber also teaches uniquely identifying the advertisement and storage control means for storing the advertisement if it does not match an ad that is already stored (col. 16, lines 25-40); including benefit information from the advertiser to the user in

Art Unit: 3622

return for presentation of the advertisement (col. 5, lines 25-45); the benefits are updated according to the number of times the advertisement is presented (one time, for example, col. 17, lines 45-55); procedure information representing a procedure for generating presentation information while updating benefits and advertisement receiving apparatus comprises presentation information generating means (col. 7, lines 45-65); validity confirming means for confirming validity of the presentation information (col. 16, lines 10-15, lines 40-65, col. 17, lines 35-60); analyzed electronic advertisement supply means for analyzing for the user advertisements information and supplying advertisement information having contents reflecting the analysis (profile information, col. 18, lines 55-60).

Additionally, Goldhaber further discloses that advertising information has unique identifiers via indexes (Fig. 15, item 466; Fig. 11a, item 182) and that content is uniquely identified via indexes on the user's computer (col 8, lines 40-50).

Goldhaber further discloses that advertising information is saved to the user computer (col 24, lines 45-50)

Goldhaber discloses that only non-duplicate advertisement information is saved on the user computer (Fig. 15; col 20, lines 10-26; col 14, lines 59-67).

Note that the offers to sell something cited (col 20, lines 10-26) above are functionally equivalent to an advertisement and also that Goldhaber discloses presenting advertising (col 1, lines 15-30).

Furthermore, in the above citation (col 16, lines 24-41), note that Goldhaber tracks what advertisement the user views, that advertisements are stored on the user's computer (advertisement receiving apparatus) when the user decides to view an ad, and that only ads that

Art Unit: 3622

the user has not already viewed are presented to the user as possible ads for viewing. Hence, Goldhaber compares advertisement identifying information to ensure that no duplicate ads are saved to the users computer.

Goldhaber further discloses that said benefits are updated according the number of times or a time period said advertisement information is presented (col 30, lines 4-8).

Goldhaber does not explicitly disclose non-duplicate local storing of advertisements that the user has not yet viewed.

However, Reilly further discloses electronic advertisement storage control means for storing said electronic advertisement received by said electronic advertisement receiving means, when said identifying information does not match said identifying information of each of said at least one electronic advertisement stored in said electronic advertisement storing means; and Reilly stores only those identifying information that does not match identifying information that has previously been stored; and Reilly does not store again if ad has been previously stored (col 12, lines 15-20; col 15, line 55-col 16, line 20; Fig. 8; Fig. 12).

Also, Reilly discloses that downloading advertisements can take a long time (col 8, lines 53-59).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Reilly's non-duplicate local storing of advertisements that the user has not yet viewed to Goldhaber's presenting of advertisements for user viewing. One would have been motivated to do this in order to provide ready access to advertisements without wasting storage space.

Art Unit: 3622

Goldhaber further discloses that said benefits are updated according to the number of times said advertisement information is presented (col 11, lines 43-55; Fig. 7, item 125 and item 126; Fig. 12).

Goldhaber further discloses the utilization of computers, networks, interfaces, and server (Fig. 1).

Claims 10, 12-15: Goldhaber and Reilly disclose the invention as discussed above.

Goldhaber does not explicitly disclose utilizing identifiers to identify advertisements during interactions.

However, Goldhaber further discloses response data representing reception of the advertisement (col 5, line 64-col 6, line 3; col 11, lines 32-44; col 16, lines 7-17; col 23, lines 1-5).

Goldhaber further discloses that advertising information has unique identifiers via indexes (Fig. 15, item 466; Fig. 11a, item 182) and that content is uniquely identified via indexes on the user's computer (col 8, lines 40-50).

Goldhaber further discloses tracking advertisement utilization and reception (Fig. 15; col 20, lines 10-26; col 14, lines 59-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Goldhaber can utilize index or other advertisement identifiers to identify advertisement during interactions. One would have been motivated to do this in order to provide a way of tracking advertisements.

Art Unit: 3622

Goldhaber further discloses targeting users with content based on geographic areas (col 2, lines 27-35; col 15, lines 15-21) and that user geographic area information is known (col 13, lines 5-11).

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (5,794,210) in view of Reilly (5,740,549) and in view of Gerace (5,848,396).

Claim 11: Goldhaber and Reilly disclose the invention as discussed above.

Goldhaber further discloses auditing or tracking transactions (col 20, lines 45-55) and presenting or distributing ads and costs associated with ads (col 7, lines 47-60).

Goldhaber does not explicitly disclose ending advertising distribution at a certain point.

However, Gerace further discloses ending advertising distribution when a calculated number reaches a predetermined number (col 12, lines 38-41; col 15, lines 12-20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace's control of the number of times an ad is presented to Goldhaber's presenting of ads. One would have been motivated to do this in order to better offer auditing information and control on advertising and the costs of advertising.

5. Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (5,794,210) in view of Reilly (5,740,549) in view of Steele (6,564,047) and in view of Rautila (6,524,189).

Goldhaber discloses the apparatus above.

Art Unit: 3622

Goldhaber further discloses multiple communications channels and networks (col 1, lines 20-25; col 3, lines 40-50; col 4, lines 13-20).

Goldhaber does not explicitly disclose utilizing a different channel for advertising information than for other communications.

However, Steele discloses that said presentation informing means informs said advertiser of said presentation information through a first communication line different (bluetooth) from a second communication line (cell net) through which said electronic advertisement receiving means receives said electronic advertisement (col 9, lines 34-50). Steele further discloses that said first communication line can be short-haul wireless communication (col 9, lines 34-50). Steele further discloses a user portable electronic apparatus (Fig. 1) and the utilization of the Internet and advertising (col 1, lines 20-25) and rewarding a user for viewing advertising (col 1, lines 25-35; col 4, lines 35-41).

Please note that Rautila defines that, "Bluetooth is a low-cost, short-haul wireless scheme that sends and receives data via cell phone, portable computer, or other device over a 2.4 GHz spread-spectrum technology" (col 5, lines 27-33).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Steele's utilizing different communication lines and wireless communications can be added to Goldhaber's utilization of the Internet and different communications channels. One would have been motivated to do this in order to provide a portability to the user and a better way of interacting or communicating with advertisement providers.



***Response to Arguments***

6. Applicant's arguments with respect to claims 1, 4, 5, 8-21 have been considered but are not found persuasive.

On page 15 of the Applicant's Amendment dated 5/18/05, Applicant states,

"In stating that 'offers. . .are functionally equivalent to an advertisement' this in fact is incorrect. See the definition of these two terms in Black's Law Dictionary. . ."

However, note that Examiner did not state that offers are functionally equivalent to an advertisement. Rather, Examiner stated on page 4 of the Office Action dated 2/28/05 that:

"Note that the offers to sell something cited (col 20, lines 10-26) above are functionally equivalent to an advertisement and also that Goldhaber discloses presenting advertising (col 1, lines 15-30)".

Hence, Examiner stated that offers to sell something are functionally equivalent to an advertisement.

Additionally, note that the online Merriam-Webster dictionary at [www.m-w.com](http://www.m-w.com) defines 'advertisement' as:

"1 : the act or process of advertising

2 : a public notice; *especially* : one published in the press or broadcast over the air".

And, the Merriam-Webster dictionary defines advertising as:

"1 : to make something known to : **NOTIFY**

2 a : to make publicly and generally known <*advertising* their readiness to make concessions> b

: to announce publicly especially by a printed notice or a broadcast c : to call public attention to

Art Unit: 3622

especially by emphasizing desirable qualities so as to arouse a desire to buy or patronize :

**PROMOTE**".

And, the Merriam-Webster dictionary defines 'offer' as:

"2 a : to present for acceptance or rejection : **TENDER** <was *offered* a job> b : to present in order to satisfy a requirement <candidates for degrees may *offer* French as one of their foreign languages>

3 a : **PROPOSE**, **SUGGEST** <*offer* a solution to a problem> b : to declare one's readiness or willingness <*offered* to help me>

5 : to make available : **AFFORD**; *especially* : to place (merchandise) on sale

6 : to present in performance or exhibition

7 : to propose as payment : **BID**".

Hence, to call public attention to so as to arouse a desire to buy is similar to present in exhibition or to place on sale or to make available or to place (merchandise) on sale.

Also, Goldhaber discloses utilizing, presenting, and receiving advertisements throughout the Goldhaber disclosure (Fig. 4, item 110, 'Advertiser'; Fig. 10, item 60(c), 'Advertiser'; Fig. 11a, 'ads', 'Ad/Profile Agent Views'; Fig. 13, item 308, 'view ad'; and below):

"A system provides for the immediate payment to computer and other users for paying attention to an advertisement or other "negatively priced" information distributed over a computer network such as the Internet. . . A further invention, Orthogonal Sponsorship, allows advertisers to detach their messages from program content and explicitly target their audience. A special icon or other symbol displayed on a computer screen may represent compensation and allow users to choose whether they will view an ad or other negatively priced information and

Art Unit: 3622

receive associated compensation. . . Private profiles may be maintained for different users and user information may be released to advertisers and other marketers only based on user permission. Users may be compensated for allowing their information to be released.

Competing advertisers may "bid" for the attention of users using automatic electronic systems, e.g., "an auction" protocol and these concepts can be generalized to provide an electronic trading house where buyers and sellers can actively find each other and negotiate transactions (Abstract);

(1) FIELD OF THE INVENTION

(2) The present invention relates to techniques for delivering information electronically, and more particularly, to techniques for delivering positively and negatively priced intellectual property (including advertising) (col 1, lines 4-8);

(101) If the consumer selects the "thumbnail" view, an associated screen is displayed (FIG. 13, block 304) that may be similar to the one shown in FIG. 11. The consumer may delete displayed ads (FIG. 13, block 306), or she may view displayed ads (e.g., by selecting displayed CyberCoins 62 or coupons 63 (FIG. 13, blocks 308, 310, 312). The consumer may also place an order for specific goods or services (e.g., in response to some displayed ads or interaction with them) (FIG. 13, block 314). The consumer may also rate a displayed ad (FIG. 13, block 316) to provide the advertiser with feedback such as "I like the ad" or "I don't like the ad." This feedback can be used to fine-tune the consumer's interest profile 124 (col 18, lines 46-60);

(110) FIG. 15 is an example of an overall process performed by system 100 to manage trading house agents. If someone wants to make a new offer to sell something (FIG. 15, block 450), system 100 can create an associated selling agent 402 (FIG. 15, block 452). Similarly, a

Art Unit: 3622

new request to purchase an item (FIG. 15, block 454) may result in creation of a buying agent 110 (FIG. 15, block 456). The above-described processes may exist concurrently with the agent functions described above in connection with attention brokering-which result in the creation of agents to "buy" or "sell" consumer attention as a commodity (FIG. 15, blocks 458, 460, 462, 464). The trading houses 400 may then create one or more indexes of items being bought and sold (FIG. 15, block 466). When a buying agent 110 and a selling agent 402 meet at a trading house computer 400, the trading house computer scans for buy/sell matches (FIG. 15, block 468), and may screen out all matches that have already been previously provided to that particular prospective buyer and/or seller to avoid duplications (FIG. 15, block 470). If the agents are empowered to consummate transactions, then the trading house computer 400 may consummate a transaction and arrange for the appropriate funds to be transferred either directly or via financial clearinghouse 109 (FIG. 15, block 472). The trading house computer 400 may then inform the consumer's computer 104 of the result of the transaction (of if the consumer's agent was not authorized to consummate a transaction, to file reports of the matches found) (FIG. 15, block 474) (col 20, lines 7-35);

(111) Thus, the trading house arrangement described above is designed to bring buyers and sellers together more quickly, less expensively, from larger populations, and with greater accuracy than any other existing sales mechanism. Some examples of possible trading house functions include an actual stock exchange, an information clearinghouse, legal services and information, medical services and information, business information, cable programs and movies, yellow pages, catalog sales, classified ads, technical journals, and community-of-interest establishment. By analogy, a trading house can be thought of as a "super bulletin

Art Unit: 3622

board," with features that distinguish from existing bulletin board systems, e.g., high capacity (millions of buyers and sellers), active merchandise targeting via buying and selling agents that seek each other out, negative pricing (ads that pay), agent-aided negotiation and bidding, trusted agent transaction consummation, trusted identity and anonymity, digital cash transactions, auditable or anonymous transactions, credit histories as private property, automatic royalty tracking, and home banking (col 20, lines 35-55);

(112) Another extension of trading houses is the automatic formation of on-line communities of interest. Existing on-line services provide "news groups" or "chat groups" dedicated to specific interests, but these must be formed "manually" and then "advertised" by email or word of mouth" (col 20, lines 55-61).

Hence, the Goldhaber discloses utilizing, presenting, and receiving advertisements throughout the Goldhaber disclosure.

On page 15, the Applicant states,

"Also, the Examiner stated that 'Goldhaber further discloses that said benefits' it is not clear from the Office Action what said benefits relates to."

Examiner notes that on page 5 of the Office Action dated 2/28/05, Examiner states,

"Goldhaber further discloses that said benefits are updated according to the number of times said advertisement information is presented (col 11, lines 43-55; Fig. 7, item 125 and item 126; Fig. 12)".

Applicant's claim 4 and 16 state, "said benefits are updated according to the number of times or a time period said advertisement information of said corresponding advertisement is presented".

Art Unit: 3622

Hence, Examiner's citation regarding said benefits is referring to Applicant's claim 4 and 16.

On page 16, Applicant states, that 'piecemeal reconstruction of prior art patents is improper'.

Examiner responds that it is the combination of Goldhaber and Reilly that renders the features of the Applicant's claim obvious. The Applicant's claimed features would be obvious to one skilled in the art in light of the combination of Goldhaber and Reilly. The citations from Goldhaber and Reilly were made to demonstrate where Goldhaber and Reilly have priorly disclosed the Applicant's claimed features and how one skilled in the art would have found the features of the Applicant's claims obvious.

Also, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Also, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed

Art Unit: 3622

invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

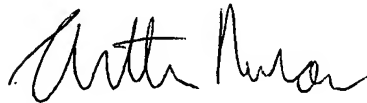
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, appearing to read 'Arthur Duran'.

Arthur Duran  
Patent Examiner  
6/28/05